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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/024,174	12/21/2001	Syuichi Kudou	0152-0586P	6303
2292	7590	12/28/2004	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			SELLERS, ROBERT E	
			ART UNIT	PAPER NUMBER

1712

DATE MAILED: 12/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/024,174

Applicant(s)

KUDOU ET AL



Examiner

Robert Sellers

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) 5-9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 10 and 11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. Claims 5-9 are drawn to an invention nonelected with traverse in the response filed July 15, 2004. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144 and MPEP § 821.01).

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-4, 10 and 11 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for from 0.1-50 moles of acid groups of acid-modified olefinic resin (C) per 100 moles of amide groups in polyamide elastomer (B) wherein the polyamide is a polyether ester amide (specification, page 14, lines 23-27), does not reasonably provide enablement for the proportion for polyamide elastomers in general. The term "polyamide elastomer" embraces such structurally distinct species as polyether amides according to page 9, lines 25-27. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

The text of section 103(a) of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ueda et al. Patent No. 5,652,326.

Claims 3, 4, 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ueda et al. as applied to claims 1 and 2 hereinabove, and further in view of Tajima et al. Patent No. 5, 854,324.

The rejections are maintained for the reasons of record set forth in the non-Final rejection mailed August 25, 2004. The arguments filed November 23, 2004 have been considered but are unpersuasive.

3. The calculated moles of acid:100 moles of amide groups in the table on page 8 of the remarks section of the amendment are based solely on a polyamide elastomer (b-1) (specification, pages 43 and 45, Tables 5 and 6) which is a polyether ester amide according to page 25, line 22 to page 26, line 10. The evidence of record is not commensurate in scope with the claimed polyamide elastomer (B) which encompasses such a structurally distinct species as polyether amides (page 9, lines 25-27).

4. Example 25 shows a moles of acid:100 moles of amide groups of 51.5 which is greater than the claimed maximum of 50. Example 19 exhibits a ratio of 0.5 which is representative of the claimed minimum of 0.1. The tensile elongations as reported in the table on page 9 of the remarks section of the amendment and corroborated by Tables 5 and 6 are 130% for Example 25 and only 80% for Example 19.

5. It is unclear what constitutes an acceptable elongation value since the 80% attributed to the lower limit ratio of 0.5 is closer to the 50% of Comparative Example 17 containing low density polyethylene as resin (C)

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(i.e. a ratio of 0), whereas Example 25 with a ratio larger than the claimed maximum has a value of 130% which is significantly greater than the 80% for a ratio within the claims. The 130% elongation of Example 25 is the lowest value of a declining trend in elongation for ratios of 30.9 (Example 23, 190%) to 41.2 (Example 24, 160%). What is the criticality of the claimed upper limit of 50 when a ratio of 51.5 yields a significantly higher elongation (130%) than that for a ratio of 0.5 within the claimed ratio parameters (80%)?

The amendment necessitated the new ground of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL** (MPEP 706.07(a)). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

(571) 272-1093 (Fax no. (703) 872-9306)
Monday to Friday from 9:30 to 6:00 EST
rs 12/23/04



ROBERT E.L. SELLERS
PRIMARY EXAMINER